Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte ERNST KRAENZLER, GERD BERNER, MONIKA RENNER
and JOACHIM MUELLER

_____

Appeal No. 2004-1193
Application 09/639,324

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ON BRIEF

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Before ABRAMS, FRANKFORT, and McQUADE, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 15, which are all of the claims pending in this application.

Appellants' invention is directed to a hand-held power tool wherein the drive shaft (14) associated with the electric motor

(12) of the tool is supported on bearings (32, 118), and at least one of said bearings is supported in the manner described on page 4, lines 9-20, and in the paragraph bridging pages 12-13 of the specification. Independent claim 1 is representative of the subject matter on appeal and a copy of that claim may be found in the Appendix to appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Pew	3,873,863	Mar. 25, 1975
Wanner et al. (Wanner)	4,066,136	Jan. 3, 1978
Nichting	4,549,823	Oct. 29, 1985
Volz	5,839,349	Nov. 24, 1998
Sheedy	5,885,006	Mar. 23, 1999
Daniell	6,021,826	Feb. 8, 2000
Van Duyn	6,331,078 B1	Dec. 18, 2001 (filed May 19, 1999)

Claims 1 through 3, 14 and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Pew in view of Volz and Nichting.

Claims 4 and 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Pew and Volz "as applied to claims 1 and 3 above," and further in view of Van Duyn.

Claims 5 through 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Pew and Volz "as applied to claim 3 above," and further in view of Sheedy.

Claims 10, 11 and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Pew and Volz "as applied to claim 1 above," and further in view of Wanner.

Claim 12 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Pew, Volz and Wanner as applied to claim 10 above, and further in view of Daniell.[1]

Rather than attempt to reiterate the examiner's full commentary with regard to the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellants regarding the rejections, we make reference to the final rejection (Paper No. 7, mailed July 30, 2002) and the examiner's

[1] We observe that since the examiner's treatment of independent claim 1 mentioned in the examiner's first rejection above apparently required use of the combined teachings of Pew, Volz and Nichting, it would appear that the other rejections made by the examiner of claims dependent from claim 1 should also have included each of the three initially applied patents in combination with one of the other references subsequently added by the examiner.

answer (Paper No. 16, mailed December 23, 2003) for the reasoning in support of the rejections, and to appellants' brief (Paper No. 15, filed July 3, 2003) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we have made the determinations which follow.

In rejecting claims 1 through 3, 14 and 15 under 35 U.S.C. § 103(a) based on the combined teachings of Pew, Volz and Nichting the examiner has found (final rejection, page 2) that Pew discloses

> a hand power tool (10), comprising a housing (12); a motor (M) arranged in the housing (12) and having a drive shaft (16) with two opposite ends; bearings (24,36) each supporting one of the ends of the drive shaft (16) in at least one component (20; column 3, lines 37-38, column 4, lines 46-50); an insert tool (38; column 3, lines 58-61): a drive element (36) [sic] through which the said drive shaft (16) is operatively connected with the insert tool (38; column 3, lines 58-61), at least one of the bearings (24, 36) of the drive shaft (16) being supported on the component (20) over one part of its length in a radial direction

> through a sliding seat[60] (figures 2-4), and also being supported on the component (20) over another part of its lengths in the radial direction through a ring (10) [sic], wherein a first of two outer edges of the bearing (24) is supported on the component (22; figure 3, far right side of bearing 24) and a second of the two outer edges is supported by the ring (22). Pew does not disclose the material of the ring (22) as being a synthetic plastic, but merely states that the material is electrically nonconductive (column 5, lines 1-3).

To account for the above-noted difference, the examiner looks to Volz, urging that this patent teaches use of a plastic ring (23) as an elastomeric silencing material to be used in contact between a bearing (21) supporting a drive shaft and a housing (1). From such teachings, the examiner concludes that it would have been obvious to one of ordinary skill in the art at the time appellants' invention was made to modify the hand power tool of Pew "to include the plastic ring of Volz for the purpose of including a synthetic ring over the bearing supporting the drive shaft of the hand power tool" (final rejection, page 3).

In addition, the examiner relies upon Nichting as teaching a bearing (16) supporting a shaft (12), with the bearing being supported by an elastomeric ring (60) and a component (14), wherein the component (14) purportedly supports a first of two outer edges of the bearing (16) over one part of its length in a

radial direction and a second outer edge of the bearing over its length in the radial direction "through a ring (60) [sic, 60''']." The examiner then concludes that it would have been obvious to one of ordinary skill in the art at the time appellants' invention was made

> to further modify the apparatus of Pew in view of Volz to support the bearing radially as taught by Nichting, for the purpose of providing a snug and tight fight [sic, fit] about the bearing and synthetic plastic ring (Nichting-column 3, lines 35-38).

After a careful consideration of the teachings of Pew, Volz and Nichting, we share appellants' view as expressed in the brief (pages 7-11) that the applied references do not contain any hint or suggestion that they can or should be combined with one another in the particular manner urged by the examiner, and that even if so combined, such combination would not lead to appellants' invention as defined in claim 1 on appeal.

Even if we were to agree with the examiner that it would have been obvious to one of ordinary skill in the art at the time of appellants' invention to add an elastomeric silencing layer like that seen at (23) of Volz to the bearing (24) of Pew, we note that such combination would <u>not</u> result in appellants'

invention as defined in claim 1 on appeal, since the entirety of the outer race of bearing (24) in Pew would then be supported by an elastomeric silencing layer as shown in Volz at (23), instead of providing an arrangement wherein two different areas and forms of support for the two outer edges of the bearing are present as specified in appellants' claim 1. As for the examiner's further use of Nichting to modify the structure resulting from the initial combination of Pew and Volz, since the elastomeric ring (23) of Volz used in the bearing (24) of Pew would provide a snug and tight fit for the bearing in bearing block (22) of Pew's hand power tool, we see no reason or motivation to further look to Nichting for any such teaching. Moreover, following the teachings of Nichting to modify the initial combination of Pew and Volz would appear to result in a structure like that seen in Nichting (Figure 1) and not that specified in claim 1 on appeal and as generally shown in appellants' drawing Figures 1, 2, 11, 13 and 14 of the present application.

For the above reasons, we will not sustain the examiner's rejection of claim 1, or claims 2, 3, 14 and 15 dependent thereon, under 35 U.S.C. § 103(a) as being unpatentable over Pew in view of Volz and Nichting.

We have also reviewed the patents to Van Duyn, Sheedy, Wanner and Daniell applied by the examiner against dependent claims 4 through 13 on appeal under 35 U.S.C. § 103(a). However, we find nothing in these references which alters our view of the examiner's basic combination of Pew, Volz and Nichting as discussed above. Thus, the examiner's rejection of dependent claims 4 and 9 under 35 U.S.C. § 103(a) as being unpatentable over Pew and Volz "as applied to claims 1 and 3 above," and further in view of Van Duyn; claims 5 through 8 under 35 U.S.C. § 103(a) as being unpatentable over Pew and Volz "as applied to claim 3 above," and further in view of Sheedy; claims 10, 11 and 13 under 35 U.S.C. § 103(a) as being unpatentable over Pew and Volz "as applied to claim 1 above," and further in view of Wanner; and claim 12 under 35 U.S.C. § 103(a) as being unpatentable over Pew, Volz and Wanner as applied to claim 10 above, and further in view of Daniell, are also not sustained.

In accord with our above determinations, it follows that the decision of the examiner rejecting claims 1 through 15 of the present application is reversed.

REVERSED

NEAL E. ABRAMS Administrative Patent Judge	)	
CHARLES E. FRANKFORT Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
JOHN P. McQUADE Administrative Patent Judge	)	

CEF:pgc

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